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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,689	07/30/2001	Trevor D. Hitchin	10004198-1	2188

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER
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RAHIMI, IRAJ A

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/918,689	<b>Applicant(s)</b> HITCHIN, TREVOR D.	
	<b>Examiner</b> (Iraj) Alan Rahimi	<b>Art Unit</b> 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. In papers filed on June 10, 2005 applicant amended claims 1, 10-13, 17 and 19-20.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1, 10 and 17 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-5, 7, 10, 11 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berg et al. (US patent 6,362,897) in view of Gerbaulet (US patent 5,544,040).

Regarding claim 1, Berg discloses a customized form output apparatus, the apparatus comprising:

a) electronic data storage, in a unitary business machine with a top, bottom, front, back and two sides, for storing preselected customized forms (hard drive 16);

b) a display 12 connected to the data storage for displaying stored forms;

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c) a selector on said unitary business machines (touch screen monitor 12) connected to the data storage for selecting form the display.

However, Berg does not disclose a unitary business machine nor does it disclose a hard copy printer in said unitary business machine connected to the data storage for printing of hard copy of said forms as selected.

Gerbaulet discloses a unitary business machine 15, having an integral hard copy printer 14 connected to storage means 12 and 13.

Berg and Gerbaulet are combinable because they are from the same field of endeavor, which is printing pre-selected materials. Gerbaulet in column 3, lines 4449 discloses various uses of the box 15 which includes but not limited to recipes and rules governing a balanced diet. Examiner considers these uses to be equivalent to preselected forms for printing. Examiner interprets forms to be any form of media having some specified information on it.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to make the printer integral to the system.

The motivation/suggestion to do so would have been to make easy and viewable list of items being purchased by the consumer.

Therefore, it would have been obvious to combine Berg with Gerbaulet to obtain the invention as specified in claim 1.

Regarding claim 2, Gerbault discloses the apparatus of claim 1 further comprising a wall mount connected to the back for mounting the apparatus on a wall (column 4, lines 32-39).

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Regarding claim 3, Berg discloses the apparatus of claim 1 wherein said data storage is a hard drive 16 conformed to receive electronic input for new customized forms and to store input forms.

Regarding claim 4, Gerbaulet discloses the apparatus of claim 1 wherein said display is a flat panel display (column 3, lines 1-10).

Regarding claim 5, Gerbaulet discloses the apparatus of claim 1 wherein said selector is a touch screen overlaying said display (column 3, lines 1-10).

Regarding claim 7, Berg discloses the apparatus of claim 1 wherein said selector further comprises user selections from a group including select, print, and cancel (Fig. 4).

Regarding claim 10, argument analogous to those presented for claim 1, are applicable. Gerbaulet also discloses in Fig. 3, and column 4, lines 32-39, a wall mounted unitary box 15. The power source connection to the box is inherent in Berg and Gerbaulet as their systems/devices would not work without source of power.

Regarding claim 11, Gerbaulet does not disclose the kiosk of claim 10 wherein the unitary box is conformed in size to approximately match the length and width of a sheet of letter sized or legal sized paper.

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Gerbaulet discloses his invention in a shape as shown in 3. Examiner considers the size of the box to be a matter of design choice. Size of the box can be adapted to fit a particular need based on customer interaction, space availability, cost, etc. Therefore it would have obvious to make the box approximately the size of a letter or legal paper to keep it small enough to fit in small places.

Regarding claim 14, Gerbaulet discloses the kiosk of claim 10 wherein said box is conformed to hold fifty to one hundred sheets of paper for printing. It is obvious in Gerbaulet that the Kiosk would hold over 100 sheets of self-adhesive paper for printing stamp indicia on them, because such Kiosk would be expected to dispense several hundred stamp indicia before loading more paper. Gerbaulet also discloses in paragraph 45 that his system could be used for other than printing stamps such as buying tickets and paying bills.

Regarding claim 15, argument analogous to those presented for claim 5, are applicable.

Regarding claim 16, argument analogous to those presented for claim 3, are applicable.

Regarding claim 17, argument analogous to those presented for claim 1, are applicable.

Regarding claim 18, argument analogous to those presented for claim 11, are applicable.

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5. Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berg et al. (US patent 6,362,897) in view of Gerbaulet et al. (US patent application 2002/0046195) and further in view of Mansutti.

Regarding claim 6, Berg and Gerbaulet do not disclose the apparatus of claim 1 further comprising a battery for providing power for operation. Mansutti discloses battery pack 25 to operate the portable computer having a memory, display, printer, etc.

Berg, Gerbault and Mansutti are combinable because they are from the same field of endeavor, which is displaying objects.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to have battery operate the Berg printing system.

The motivation/suggestion to do so would have been to have backup source of power in case of power outage.

Therefore, it would have been obvious to combine Berg, Gerbault and Mansutti to obtain the invention as specified in claim 6.

Regarding claim 15, argument analogous to those presented for claim 6, are applicable.

6. Claims 8, 9, 12, 13, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berg et al. (US patent 6,362,897) in view of Gerbaulet et al. (US patent application 2002/0046195) and further in view of Smith (US patent 5,995,942).

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Regarding claim 8, Berg and Gerbaulet do not disclose the apparatus of claim 1 further comprising a paper holder connected to said integral printer and to the back of the apparatus. Smith discloses a paper holder in Fig. 2 and column 4, lines 35-42.

Berg, Gerbaulet and are Smith are combinable because they are from the same field of endeavor, which is printing objects.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to put the paper holder in the back of a printer apparatus.

The motivation/suggestion to do so would have been to ease loading of paper.

Therefore, it would have been obvious to combine Berg, Gerbaulet and Smith to obtain the invention as specified in claim 8.

Regarding claim 9, Smith discloses the apparatus of claim 1 wherein said hard copy of a selected form is dispensed from the bottom of the apparatus and paper for printing is input at the top of the apparatus (Fig. 4).

Regarding claim 12 and 19, argument analogous to those presented for claim 8, are applicable.

Regarding claim 13 and 20, argument analogous to those presented for claim 9, are applicable.



***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

***Other Prior Art Cited***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Forsythe (US patent 5,249,103) discloses modular transaction terminal having a built in printer and display.

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***Contact Information***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Iraj) Alan Rahimi whose telephone number is 571-272-7411.

The examiner can normally be reached on Mon.-Fri. 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.

  
Alan Rahimi  
September 19, 2005

  
TWYLLER LAMB  
PRIMARY EXAMINER